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#23

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Michael Reed et al.	:	Confirmation No. 3543
Serial No.:	08/113,955	:	Art Unit: UNASSIGNED
Deposited:	August 31, 1993	:	Examiner: DAVID BUCCI
For:	MULTIMEDIA SEARCH SYSTEM	:	

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**NON-PARTY DENSO'S PETITION TO SUSPEND THE RULES UNDER 37 C.F.R.
§ 1.183 AND OPPOSITION TO REQUEST FOR RECONSIDERATION OF DISMISSAL
OF PETITION UNDER 37 C.F.R. §1.53(B) AND/OR 37 C.F.R. §1.182 FOR
GRANT OF A FILING DATE AND AMENDMENT OF APPLICATION**

DENSO Corporation ("DENSO") respectfully petitions the Petitions Office under 37 CFR § 1.183 to suspend the regulations and consider DENSO's Opposition to Applicants' Petition for Reconsideration filed October 6, 2008. DENSO's Opposition begins on page 3 of this Paper.

DENSO has no ownership interest in the above-captioned application. Nevertheless, DENSO has an interest in these proceedings because the Applicant's assignee, Encyclopedia Britannica, is asserting patents claiming to be continuations of the U.S. Patent Application Serial No. 08/113,955 ("the '955 Application") in litigation in the Western District of Texas. DENSO Corporation is a Defendant in that litigation who would suffer harm if the Request For Reconsideration relating to the '955 Application is granted and therefore justice requires consideration of DENSO's Opposition. DENSO is a non-party with respect to these Patent Office proceedings.

The Office of Petitions' August 6, 2008 Decision denied all grounds of the Petitioner's pending Petition on multiple grounds. In so doing, the Decision made clear that the Patent Office has no statutory authority to grant the petition under any circumstances. The Decision went further, making it clear that "[a]s over 13 years 8 months have passed between that action and the instant petitions, the instant petitions are dismissed as untimely" under 37 CFR 1.181(f). (8/6/08 Decision at 6.) Applicant does nothing to address these defects in its Request for Reconsideration. The Petition was correctly denied; reconsideration must be denied; and any grounds for claiming priority through the abandoned '955 Application must be denied.

OPPOSITION

I. PRELIMINARY STATEMENT: PETITIONER PROVIDES NO BASIS FOR RECONSIDERATION

In 1993, Petitioner deposited the '955 Application with an admittedly incomplete specification, no filing fee, no inventors' declaration, and no claim to priority to any earlier application. This '955 Application was never co-pendent with any earlier application. The Patent Office notified Petitioner of these defects on no fewer than three occasions between 1993 and 1995. The attorneys who deposited the '955 Application were provided ample opportunity to cure its defects. Petitioner decided to forego these opportunities and intentionally abandoned the '955 Application in 1995.

Thirteen years later, Petitioner seeks to assert patents that claim priority to the '955 Application in litigation in the Western District of Texas. Incredibly, despite receiving several timely notices from the Patent Office, Petitioner now claims that it first became aware of the fatal problems with the '955 Application on October 5, 2007, when the defendants in that litigation moved for summary judgment of invalidity based on the incompleteness of the '955 Application. In November 2007, in an attempt to avoid the proper entry of summary judgment, Petitioner—without any procedural or substantive basis—asked the Commissioner for Patents for the opportunity to complete the specification, pay the filing fee, provide an inventors' declaration, and claim to priority to an earlier application—omissions that Petitioner ignored when such corrective actions might have been timely, and then for almost 14 years more. Petitioner's November 2007 Petition was extraordinary by any measure, and in August 2008 the Petitions Examiner correctly denied the Petition, holding that the statutory requirements were not met and the Patent Office had no authority to act in derogation of a Federal Statute; that the petition was untimely; that the '955 Application failed to reference any prior application, did not

authorize payment of filing fees, and was not co-pending; and that no filing date could be granted under any of Petitioner's theories.

By its Request for Reconsideration, Petitioner now seeks yet another chance to correct the defects in its abandoned '955 Application—defects that could only properly have been corrected more than a decade ago. But nothing has changed since Petitioner filed its original Petition, and it offers no explanation or bases in its Request for Reconsideration to support any contention that the rejection of that Petition was incorrect or should be changed. Instead, as to some of the bases for the rejection, Petitioner blames the Patent Office for its own lack of reasonable care and diligence. Petitioner's Request for reconsideration states no cognizable basis for determining that the 2007 Petition was timely, and ignores altogether the unmet requirement for co-pendency, a requirement that cannot be cured retroactively.

Petitioner's remaining arguments, relating largely to prosecution of other applications and failed attempts (in 2008) to secure inventors' declarations, are irrelevant and only distract from the unresolved—and unresolvable—defects of the '955 Application. In sum, Petitioner seeks extraordinary relief for a second time without any reasonable basis.

II. RELIEF REQUESTED

DENSO requests that the Office of Petitions DENY the Request for Reconsideration; and again DENY the "PETITION UNDER 37 C.F.R. §1.53(b) and/or 37 C.F.R. §1.182 FOR GRANT OF A FILING DATE AND AMENDMENT OF APPLICATION" filed on November 1, 2007, by Petitioner Abraham Hershovitz. The Office of Petitions is further requested to DECLARE that the papers deposited August 31, 1993, and assigned Serial No. 08/113,955, are NOT ENTITLED TO A FILING DATE, and that any claim to the priority of Serial No. 08/113,955 is void.

III. PETITIONER CANNOT FIX DEFECTS IN THE '955 APPLICATION THIRTEEN YEARS AFTER THE FACT THAT IT INTENTIONALLY DECIDED NOT TO ADDRESS IN 1993-95.

Petitioner's Request for Reconsideration asks for yet another chance to re-write history and undo its intentional actions from 13 years ago. Petitioner repeatedly states in its Request that the first time it became aware of any problems with the filing date or priority of the '955 Application was October 5, 2007. (10/6/08 Req. for Recon. at 5,6,9.) That contention is demonstrably false. "[P]etitioner was on notice that the application was not accorded a filing date and was apparently aware of that fact as evidenced by their filing of a petition on October 29, 1993 requesting a filing date be granted. As such, petitioner knew or should have known that a benefit claim to the instant application was improper" August 6, 2008 (8/6/08 Decision at 7.) In fact, the Patent Office issued three papers in 1993 and 1995, each of which served notice to the Petitioner of the defects in the Application, the proper methods of cure, and the implications of Petitioner's failure to cure:

- The Patent Office sent Petitioner a Notice of Incomplete Application on September 13, 1993.
- The Patent Office issued a Decision denying Petitioner's Petition for Granting a Filing Date on February 16, 1994.
- The Patent Office issued a March 23, 1995 Notice of Abandonment.

Petitioner asks the Patent Office to retroactively waive statutory requirements and well-established Patent Office procedure to change the consequences of Petitioner's own deliberate choices. "Circumstances resulting from petitioners', or petitioners' counsel's, failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. . . . failure to know and properly apply the rules of practice before the USPTO is not a basis for seeking waiver of the rules under 1.183." (8/6/08 Decision at 7.) As

set forth in detail below, though, Petitioner's lengthy submission does nothing to change the facts that: (a) Petitioner never completed the '955 Application; (b) Petitioner's '955 Application never claimed priority to an earlier application; (c) Petitioner never paid the required fees for the '955 Application; and (d) the '955 Application was never co-pending with a continuation application. Any one of these four flaws is sufficient to prevent Petitioner from obtaining a filing date for the '955 Application, and unequivocally supports the Patent Office's proper denial of the 2007 Petition.

A. Petitioner Never Completed the '955 Application

There is no dispute that the '955 Application Petitioner deposited was incomplete. Petitioner also agrees that the Patent Office proposed two alternatives *in 1993* for correcting the '955 Application. First, Petitioner could have filed the missing information, together with a supplemental oath or declaration by the inventors referring to the original specification and, the Patent Office would have granted the '955 Application a filing date on the date it received page 1. (2/16/1994 Decision on Petition at 2.) Petitioner chose not to do so. Second, Petitioner could have claimed that the omitted page was unnecessary by providing an "oath or declaration by the inventors as required by MPEP 608.01." (Id. at 1.) Petitioner conveniently now claims that, after receiving the September 13, 1993 Notice of Incomplete Application, it "opted for the latter option." (10/6/08 Req. for Recon. at 3.) But Petitioner provides no evidence that it ever complied with the requirements to satisfy that option, and, in fact, Petitioner never did so. No oath or declaration by the inventors was ever filed, as required by MPEP 608.01, and no other actions were taken.

1. Petitioner Never Provided the Required Declaration

Petitioner did not submit—and still has not submitted—any oath or declaration and has no basis for claiming it chose either option. "[T]he petition was not accompanied by an oath or

declaration by the inventors as required by MPEP 608.01." (8/6/08 Decision at 1.) Indeed, Petitioner admits that it "had some difficulty in obtaining all the inventors' signatures on the Declaration" and that on February 16, 1994 the Patent Office dismissed the '955 Application for a lack of a declaration. (10/6/08 Req. for Recon. at 4.) At bottom, Petitioner never submitted any declarations from any inventor, and by its own admission, cannot do so even now. MPEP 608.01 was not, has not been, and cannot be satisfied under these circumstances.

Petitioner likewise does not submit any evidence regarding any attempt to obtain any declaration in 1993, 1994, or 1995. Furthermore, Petitioner never asked for any relief pursuant to 37 CFR § 1.47 in 1993, 1994, or 1995, and offers no evidence that would have supported any exception under that regulation before Petitioner abandoned the '955 Application.

Petitioner claims that "but for the error related to copying all the pages of an application. . . none of the subsequent events that led to the problems encountered herein would have been a factor." (10/6/08 Req. for Recon. at 10.) This is irrelevant, and given that no declaration ever existed, simply not true. In fact, even now, despite attaching 250 pages of exhibits to its Request for Reconsideration, Petitioner fails to attach a declaration from even one of the inventors.

Based solely on *attempts* to contact inventors in 2008—attempts that Petitioner admits were unsuccessful—Petitioner now requests, for the first time, an exception to the requirement for an inventor's declaration pursuant to 37 C.F.R. § 1.47, entitled "Filing when an inventor refuses to sign or cannot be reached." (Req. for Recon. at 8.) But Petitioner's 2008 attempts to contact the inventors cannot satisfy the requirements for entitlement to the relief sought. Specifically, 37 C.F.R. § 1.47 provides:

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. ***The oath or declaration in such an application must be accompanied by a petition including proof of the***

pertinent facts, the fee set forth in § 1.17(g), and the last known address of the nonsigning inventor.

37 C.F.R. § 1.47 (emphasis added). Petitioner provided no proof of the pertinent facts, no fee, and no declaration of another inventor as required by 37 C.F.R. § 1.47. Petitioner fails even to include the proposed declarations allegedly sent to its inventors and omits any correspondence to or from those inventors. In fact, Petitioner neglects to advise the Patent Office as to why the named inventors refused to sign Petitioner's proposed declarations, first in 1993, and once again, now. Certainly, such information is pertinent to Petitioner's Request.

2. An Extension of Time Was Not Available in 1993 and is Not Available Now

In truth, Petitioner failed to exercise either option for correcting the '955 Application's missing information that was provided by the Patent Office in the September 13, 1993 Notice of Incomplete Application. And despite Petitioner's litigation-induced contention that it opted for the second of these options, the record of the prosecution of the '955 Application is unequivocal that Petitioner submitted only a Petition for Extension of Time on February 28, 1994.

Petitioner argues that an extension of the two month period for responding to the September 13, 1993 Notice of Incomplete Application should *now* be extended because "the language of 37 C.F.R. § 1.181(f) is intentionally permissive in nature to permit consideration of petitions filed long after a decision or notice is rendered." (10/6/08 Req. for Recon. at 6.) In fact, the language of 37 C.F.R. § 1.181(f) is not permissive, did not allow the PTO to grant the Petition for an Extension of Time in 1993, and do not allow the PTO to grant an extension of time now:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. *This two-month period is not extendable.*

37 C.F.R. § 1.181(f) (emphasis added).

Petitioner argues that, because it filed its Petition for an Extension of Time, “[t]he decision of February 16, 1994 no longer required a response.” (Id. at 6.) Even if the extension of time had ever been allowable, however, Petitioner chose not to complete the application even after the Petitioner’s four month requested extension period elapsed. Indeed, the Patent Office sent Petitioner a Notice of Abandonment on March 23, 1995—more than a year after the Petition for Extension of Time—to which Petitioner never responded.

3. The “Continuation Application” Cannot Cure the ‘955 Application

Facing the unassailable record of its own decision not to complete the ‘955 Application, Petitioner next argues that the “continuation application” it subsequently filed somehow remedied the fatal defects of the ‘955 Application. (10/6/08 Req. for Recon. at 4.) Petitioner suggests that “from the Applicant’s attorney’s perspective, prosecution was to continue in the child application without a need to continue prosecution of either of the two sandwich applications.” (Id. at 6; see also id. at 7 (“Rather Applicant chose to pursue patenting of the invention in a continuation application, making the petition process obsolete.”).) In the first place, “Applicant’s attorney’s perspective” is irrelevant. “[F]ailure to know and properly apply the rules of practice before the USPTO is not a basis for seeking waiver of the rules.” (8/6/08 Decision at 7.) In any event, Petitioner provides no authority for the proposition that a continuation application can cure defects or complete a prior application, and in fact no such authority exists. Petitioner just ignores MPEP 202.02, cited by the Petitions Examiner in the August 6, 2008 Decision, which states:

The inclusion of prior application information in the patent does not necessarily indicate that the claims are entitled to the benefit of the earlier filing date.

MPEP 202.02 (cited in 8/6/2008 Office of Petitions Decision at 7). "[T]he granting of a filing date petition in a child application and the examination of such child application are irrelevant to the actions taken in the [parent] application." (8/6/08 Decision at 7.)

Similarly, Petitioner argues that the Patent Office's was obligated to remind the Petitioner of its own decision not to complete the '955 Application during its review of the "child application," and that the Patent Office's failure to remind Petitioner effectively cured or completed the filing of the '955 Application. (10/6/08 Req. for Recon. at 5-6.) This position is unsupportable, and Petitioner has, once again, provided no authority for its arguments. In sum, Petitioner's argument about the "continuation" must be rejected.

4. The Separate '893 "Sandwich Application" Cannot Cure the '955 Application

The Petitioner likewise ignores the Petitions Office's reminder that "the issue at hand is not. . . what actions petitioner may have taken in another application" (8/6/2008 Office of Petitions Decision at 7), and attempts to make something of the fact that it deposited a second, similar but separate application on the same day it deposited the '955 Application. Petitioner refers to this second application as the "first sandwich" application—Application Number 08/113,893. (Req. for Recon. at 3.) Although Petitioner now claims that the '893 Application was complete on the deposit date (10/6/2008 Req. for Recon at 2), Petitioner admitted in its October 6, 2008 Petition regarding the '893 Application that the '893 Application was also incomplete and did not contain any inventor declaration. (10/6/2008 Petition at 5.) And in any event, Petitioner expressly abandoned the '893 Application on October 29, 1993. (10/6/2008 Req. for Recon at 3.)

Nonetheless, Petitioner now claims that despite its express abandonment of the '893 Application, "there was never an intent to abandon both applications or in any way not to obtain

a filing date for one application.” (10/6/2008 Req. for Recon. at 4.) But Petitioner’s ‘893 Application was also never completed, was also never entitled to a filing date, and was also expressly abandoned. It cannot cure or correct the fatally defective ‘955 Application. Petitioner received a notice of abandonment for the ‘955 Application in 1995, and by its own admission, Petitioner decided not to pursue or complete that application. (10/6/2008 Req. for Recon. at 7.) Petitioner fails to explain how the mere existence of the separate ‘893 application, abandoned and incomplete long before Petitioner expressly abandoned the ‘955 Application, could justify the relief it requests.

B. Petitioner’s ‘955 Application Never Claimed Priority to An Earlier Application

Petitioner argues that its omission of the first page of the specification was not “critical” because the “reference to the parent application which usually appears on page 1 of the Specification *can* appear in the Declaration under 37 C.F.R. § 1.63 or *could be* added at a later date by way of a preliminary amendment.” (10/6/08 Req. for Recon. at 3 (emphasis added).) This is irrelevant because Petitioner admittedly never provided any such Declaration nor any such Preliminary Amendment. The procedures of the Patent Office establish clearly and unambiguously the process by which the Petitioner could have corrected the defect—which process was clearly explained to Petitioner by the Patent Office during prosecution of the ‘955 Application—and Petitioner deliberately elected *not* to comply with that procedure. “The requirements of 35 U.S.C. 111 and 35 U.S.C. 120 have not been met” -- and Petitioner's paper never explains how it intends to get around these statutory failures.

C. Petitioner Never Paid the Fees for the ‘955 Application

In addition to these formal defects, Petitioner never paid the required filing fees for the ‘955 Application. In its decision on the Petitioner’s November 2007 Petition, the Petitions

Office determined that “no blanket fee authorization was given.” (8/6/2008 Decision at 6.) In reaching that conclusion, the Petitions Office examined the most permissive language in Petitioner’s 2/28/1994 Petition for Extension of Time (the third paragraph) that:

In the event that a further petition for an extension of time is required to be submitted at this time, applicant(s) hereby [petitions(s) under 37 C.F.R. 1.136(a) for an extension of time for as many months as are required to ensure that the above-references application does not become abandoned. *Any fees should be charged to Deposition Account No. 04-1073.*

(8/6/2008 Decision at 6-7 (citing 2/28/1994 Petition for Extension of Time at 5-6) (emphasis added)).

Petitioner now claims that the Petitions Office ignored the second paragraph of its Petition for Extension of Time. But the language on which Petitioner now purports to rely is even less permissive than that quoted by the Petitions Office in its August 2008 Decision:

If no check is attached and a fee is due or if the check enclosed is insufficient, the Commissioner is authorized to charge any fee or additional amounts *due in connection with this communication* to Deposition Account No. 04-1783.”

2/28/1994 Petition for Extension of Time at 22. In any event, both of Petitioner’s statements appeared in the context of its February 28, 1994 Petition for Extension of Time, which, as discussed above, was never allowable and was never allowed.

Petitioner further suggests that because the 1993 version of 37 C.F.R. § 1.22(b) stated that “the fees . . . *should* be itemized in each individual application” and a later version of the rule stated that “the fees . . . *must* be itemized in each individual application,” this amendment somehow reflects that itemization of fees was not “mandatory” in 1993. (10/6/2008 Req. for Recon. at 9.) Petitioner’s argument misses the point: regardless of whether such itemization was an absolute requirement, Petitioner never provided a *non-itemized* fee authorization. The fees were not paid, and Petitioner has no excuse for its failure to authorize—or pay—the required filing fees in 1993 when they were due.

D. The '955 Application Was Never Co-Pending

Petitioner's Request for Reconsideration does not so much as mention the requirement for co-pendency, which the Petitions Office held was not met. (8/6/2008 Decision at 6.) Thus, even if each and every of the above issues were now resolved—and none of them have been—the '955 Application was never co-pending with U.S. Patent 5,241,671 or U.S. patent 6,546,399. Given that almost 14 years have now passed, even an allowance of retroactive waiver of the rules Petitioner chose not to follow could not provide co-pendency where it did not originally exist. "The requirements of 35 U.S.C. 111 and 35 U.S.C. 120 have not been met. [N]o Executive branch agency may act in derogation of a federal statute." (8/6/2008 Decision at 7.)

VI. CONCLUSION

Petitioner's Request for Reconsideration provides no basis on which the Commissioner for Patents' decisions were not correct. The Petition was untimely—by nearly 14 years—and in response to it, the Commissioner correctly determined that the '955 Application did not reference any prior application, did not authorize payment of filing fees, was not co-pending, and the '955 Application is not entitled to a filing date. The Request for Reconsideration should be denied.

Respectfully submitted,

Dated: January 6, 2009

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CERTIFICATE OF SERVICE

I certify that on January 6, 2009, copies of the foregoing Opposition was served by express courier to:

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